

## REMARKS

### **35 USC § 101**

#### **Claims 1, 31, 65, and 87.**

The Examiner provided this rejection prior to the resolution of Bilski by the U.S. Supreme Court. The Supreme Court has stated that “[t]he machine-or-transformation test is not the sole test for patent eligibility under §101... that although that test may be a useful and important clue or investigative tool, it is not the sole test for deciding whether an invention is a patent-eligible “process” under §101... [t]he court is unaware of any ordinary, contemporary, common meaning of “process” that would require it to be tied to a machine or transformation of an article.”

In view of the admonitions of the U.S. Supreme Court, this rejection is properly withdrawn and, if the Examiner maintains that there are still issues under 35 USC § 101, then the rejection should be presented in a manner that is consistent with the Supreme Court holding in Bilski.

Nonetheless, for purposes of expediency, and to assist the Examiner by reducing outstanding issues, Applicant has amended Claims 1, 31, 65, and 87, consistent with current USPTO practice as understood by Applicant, to comport with the requirements of 35 USC § 101. As such, this rejection is deemed to be traversed and withdrawal thereof is indicated.

#### **Claims 2-30, 32-63, 66-68, and 88-89.**

All of these claims are dependent upon Claims 1, 31, 65, and 87, respectively. In view of the traversal of the rejection Claims 1, 31, 65, and 87 under 35 USC § 101, these claims, as well, comport with the requirements thereof.

### **35 USC § 103**

The Examiner rejects Claims 1-7, 11-18, 20, 22-26, 31-37, 41-51, 53-56, 58, 63-67, 76-77, 79, 81-83, 86, 87, 89, 90, 92, 93, and 101-103 as being unpatentable over Williams *et al*, U.S. patent no. 6,618,734 (hereinafter "Williams") in view of Turnasella, U.S. patent application publication no. 2003/0145015 (hereinafter "Turnasella"). Applicants wish to thank Examiner for the comments and provide the following comments and claim amendments to overcome the rejection.

#### **Claims 1, 31, 93, 102-103**

As noted by the Examiner, Williams discloses a surveying system for the purpose of pre-employment screening. However, the teachings of Williams are deficient in several ways that the claimed invention addresses.

Williams, as well as other prior art solutions, takes a rigid approach when presenting survey questions to a user. The path of questions is deterministic and so, therefore, is the particular conclusion resulting from the series of answers. This is shown, for example, with respect of Williams' Fig. 3 where the candidate enters the Zip Code or Location Code in 114. According to 116, if there are no openings the candidate does not continue to be surveyed for the job. As a result, a perfect candidate may be rejected merely because of a single question to which the "wrong" answer was provided. This is the typical case for these kinds of prior art surveying systems.

By contrast, the claimed invention allows for tailoring of the sequence of questions that is based on the affinity groups with which a user profile may be associated. Specifically, Williams does not teach the comparison of an entire user profile to an affinity group. The only thing that Williams teaches, if one takes the interpretation of the Examiner that Williams teaches the creation of a user profile and the creation of affinity groups, is the storing of a single user profile in

a single affinity group. No comparison whatsoever is suggested by Williams.

Applicant notes that Williams does not even teach the creation of a profile, but rather the determination that a specific user taking the survey meets the interview hard-coded criteria and therefore may be further interviewed. While this could constitute profiling, it does not mean that a profile of the user is stored in memory. Moreover, there is no need, according to Williams, to make comparisons between profiles and affinity groups because the match is one-to-one. This is a disadvantage in a world where perfect matches may be few and, in some cases, a less qualified candidate may get the interview for merely answering "right" a series of hard-coded questions.

It is further noted that Turnasella does not cure or otherwise correct any of the above mentioned deficiencies of Williams. Therefore, in view of the comments above and the proposed amendments to the claims the rejection should be withdrawn and the claim allowed.

Further, Claim 102 should be allowed for at least being a dependent claim of allowable subject matter.

#### **Claims 93 and 101**

The rejection is not understood and is possibly misplaced. Regardless, Applicant is of the opinion that these claims should be allowed for at least being dependent claims of allowable subject matter.

#### **Claims 2 and 32**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

### **Claims 3 and 33**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

### **Claims 4 and 34**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

### **Claims 5 and 35**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

### **Claims 6 and 36**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

### **Claims 7 and 37**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

### **Claims 9 and 39**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claims 11 and 41**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claims 12 and 42**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claims 13 and 43**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claims 14 and 44**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claims 15 and 45**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as

may be necessary at a later stage of the prosecution.

#### **Claims 16 and 46**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claim 17**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claim 18**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claims 20 and 50**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claims 22 and 53**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

**Claims 23 and 54**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

**Claims 24 and 55**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

**Claims 25, 26, and 56**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

**Claim 48**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

**Claim 49**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

**Claim 51**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claim 58**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claim 63**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claim 64**

Applicant respectfully disagrees that the claim as amended is disclosed by Turnasella. Specifically, Turnasella suffers from the same deficiencies that are present with Williams. Namely, Turnasella is unable to tailor a sequence of questions to a user but, rather, each point at which a question is answered becomes a point of no return and directs the profile, if at all existent, into a separate route of a similar profile answering differently a single question. That is, Turnasella is hard coded and can only provide a deterministic recommendation. By contrast, the operation of the claimed invention, as described in greater detail above in connection with the comments to Claim 1, is different. Briefly, the profile of a user is kept as a collection of questions and answers thereto which enable continued comparison and matching of the user profile with affinity groups as they are created. None of these teachings and capabilities are shown by either Turnasella or Williams, either alone or in combination. Therefore, in view of the comments above and the amendments to the claim, the rejection should be



withdrawn and the claim allowed.

#### **Claim 65, 67, 83, 87, and 90**

The Examiner's comment with respect to Claim 65 that "Turnasella teaches the above limitations" is not understood because it does not refer to specific teachings of the claim. As amended, neither Turnasella nor Williams, alone or in combination, teach the claim. Arguments for that matter have been made with respect of Claim 1 and at least a portion thereof are applicable herein. Specifically, Applicant notes that neither Turnasella nor Williams teach comparison of a user profile as a whole to an affinity group. Rather, each teach a sequential and deterministic process of questions which leads to a final and unchangeable result, and as noted above, may lead to selection of a less qualified candidate. Therefore, in view of the comments above and the suggested amendments to the claim, the rejection should be withdrawn and the claim allowed.

#### **Claim 66**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claim 68**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claim 69**

The claim should be allowed for at least being a dependent claim of allowable

subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claim 70**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claim 71**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claim 72**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claims 76 and 77**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claim 81**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

## **Claim 82**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

## **Claims 86, 89, and 92**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

Claims 8, 10, 19, 21, 27-30, 38, 40, 51, 52, 57, 59-62, 73, 75, 78, 84, 85, 88, 91, and 94-98 are rejected as being unpatentable over Williams in view of Turnasella and further in view of Rosenthal *et al*, U.S. patent application publication no. 2002/0133502 (hereinafter "Rosenthal"). Following are Applicant's comments.

## **Claims 8 and 38**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

## **Claims 10 and 40**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

## **Claim 19**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claims 21, 52, and 74**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claims 27 and 57**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claims 28 and 59**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claims 29 and 61**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claims 30, 62, 73, 84, 88, and 91**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as

may be necessary at a later stage of the prosecution.

#### **Claim 60**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claim 75**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claim 78**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claim 85**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

#### **Claims 94-98**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

Claim 80 is rejected as being unpatentable over Williams in view of Turnasella and further in view of Kaehler *et al*, U.S. patent no. 6,089,284 (hereinafter "Kaehler"). Following are Applicant's comments.

#### **Claim 80**

The claim should be allowed for at least being a dependent claim of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

Claims 99-100 are rejected as being unpatentable over Williams in view of Turnasella and further in view of DeLorame *et al*, U.S. patent no. 5,948,040 (hereinafter "DeLorame"). Following are Applicant's comments.

#### **Claims 99-100**

The claims should be allowed for at least being dependent claims of allowable subject matter. However, Applicant reserves the right to specifically respond as may be necessary at a later stage of the prosecution.

In view of the foregoing comments and Applicant's amendments to the claims herein, the application is deemed to be in allowable condition. Should the Examiner deem it helpful, he is encouraged to contact Applicant's attorney, Michael A. Glenn, at (650) 474-8400.

Respectfully Submitted,

/MAG/

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